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09/632,959	08/04/2000	Sanjay M. Parekh	39518/203866	1066

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EXAMINER

ZHONG, CHAD

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/632,959

**Applicant(s)**

PAREKH, SANJAY M.

**Examiner**

Chad Zhong

**Art Unit**

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9, 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**OFFICE ACTION**

1. This action is responsive to communications:

Request for Continual Examination, filed on 11/12/2004.

2. Claims 1-12 are presented for examination.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless--

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

4. Claims 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldreth, US 6,721,795.

5. As per claim 8, Eldreth teaches a method for obtaining a geographic location of an Internet user that accesses the Internet from a private network through a proxy server, comprising:

receiving by an internal server on the private network, a request for the geographic location of the Internet user from an external server on the external network (see for example, Col. 5, lines 55-65, wherein the server is requesting geographic information of users from the selection server; Col. 6, lines 20-35);

determining, by the internal server, the geographic location of the Internet user located inside the private network (Col. 6, lines 19-34; Col. 10, lines 25-35);

sending the geographic location of the Internet user to the external server (Col. 6, lines 19-34; Col. 10, lines 24-35).

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6. As per claim 9, Eldreth teaches the method as set forth in claim 8, wherein the external network is Internet (Col. 4, lines 1-15).

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta US 2003/0065571, in view of Eldreth, US 6,721,795.

9. As per claim 1, Dutta substantially teaches the invention as claimed wherein a method for obtaining a geographic location of an Internet user that accesses an external network from a private network through a proxy server, comprising:

receiving by an external server on the external network a request for information from an Internet user through the proxy server (Fig 4, item 401; [0028]).

determining by the external server that the request for information is through the proxy server ([0028], [0031]);

redirecting by the external server the request for information to an internal server of the private network (Fig 4, item 402; [0015-0016], wherein the request for physical address location is forwarded to a dedicated server for this service); the server determining the geographic location of the Internet user (wherein the determination is done through the database located remotely from the requesting server);

receiving by the external server the geographic location from the server within the private network; and

using the geographic location of the Internet user in handling the request for information from the Internet user ([0011]; [0015-0016]).

10. Dutta does not explicitly teach the notion of Internal Server handling internal physical address resolution.

11. Eldreth teaches the above limitation see for example Col. 6, lines 29-34; Col. 10, lines 5-18, lines 25-35, wherein the location of the information database comprises of a local private network, and the utilization of the server is to determine physical geographic addresses of clients locally.

12. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Dutta and Eldreth because they both dealing with geographic information retrieval based on an input quest from a remote client. Furthermore, the teaching of Eldreth to allow local database located within the same private network as the external server would improve the accuracy and access speed of Dutta's system by zooming in on the actual physical location of a particular user rather than focusing on the proximity of user through the IP address of a proxy. Furthermore, it would have been obvious to place the database of Dutta in any remote location to improve the speed of returned result. Dutta's system can already map IP addresses to physical addresses, thus it would have been obvious to place the resolution database within the local area network to determine the precise location of the requesting clients, doing so would improve access time as disclosed further in Eldreth, Col. 10, lines 5-17.

13. As per claim 2, Dutta teaches wherein the external network is Internet ([0003]).

14. As per claim 3, claim 3 is rejected for the same reasons as rejection to claim 1 above.

15. As per claim 4, claim 4 is rejected for the same reasons as rejection to claim 2 above

16. As per claim 5-6, claim 5-6 are rejected for the same reasons as rejection to claim 1 above. Wherein the local database contains user information containing the local IP addresses, the physical addresses is also part of said database, thus database look up of user's physical geographic address is made possible, see for example Eldreth, Col. 6, lines 30-35.

17. As per claim 7, Dutta teaches the method as set forth in claim 3, wherein sending the geographic location to the external network comprises:

sending the geographic location to an external server on the external network (Fig 1, wherein the server and the database are separate entities); and

redirecting a machine associated with the Internet user to the external server ([0016]; wherein the newly acquired address information is redirected to the requesting server).

18. As per claim 10, claim 10 is rejected for the same reasons as rejection to claim 1 above.

19. As per claim 11, Dutta teaches the method as set forth in claim 10, wherein receiving the inquiry on the domain name comprises receiving the inquiry at a domain name server ([0044]; [0051])

20. As per claim 12, Dutta teaches the method as set forth in claim 10, wherein the resolving by returning the first IP address and the resolving by returning the second IP address are performed by a domain name server ([0044]; [0051-0053]).

### *Conclusion*

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "Determining Geographic Locations of Private Network Internet Users".

- i. US 6571279 Herz et al.

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ii. US 5857191 Blackwell, Jr. et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571)272-3946. The examiner can normally be reached on M-F 7:15 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BURGESS, GLENTON B can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CZ  
November 24, 2004

  
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